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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CHARLES LOUIS THOEMING 1390 WILLOW PASS ROAD, SUITE 1020 CONCORD, CA 94520			EXAMINER SHAH, AMEE A	
			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,091

Applicant(s)

FERREIRA, PHILIP

Examiner

Amea A. Shah

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 and 16-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/29/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 1-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on August 29, 2006.

Applicant's election without traverse of Group I, claims 10-24, in the reply filed on August 29, 2006, is acknowledged.

Response to Amendment

Applicant's amendment, filed August 29, 2006, has been entered. Claims 1-9 and 15 have been cancelled and claims 10, 13, 17-20 and 22 have been amended. In view of the amended claims, the 35 U.S.C. §112, second paragraph, rejections regarding the use of "may" in claims 13-22 are withdrawn. However, applicant's amendments regarding the zip code are still subject to the same 35 U.S.C. §112 rejections, as discussed below. In view of the replacement drawings, the drawing objections are withdrawn.

Response to Arguments

Applicant's arguments filed August 29, 2006, have been fully considered but they are not persuasive.

In response to applicant's argument regarding claim 19 that the prior art Holden teaches away from the present invention in that Holden requires customers or bidders to accept a bidding agreement and that in the present invention, the dealers, not customers, agree to the bidding

Art Unit: 3625

agreements (Remarks, pages 9-10), the Examiner disagrees. It is first noted that claim 19 does not disclose a participating dealer agreement. Cancelled claim 15 disclosed such a limitation, and since this limitation has been incorporated into amended independent claim 10, the Examiner will address this argument to the extent it pertains to amended claim 10. Holden does not teach away from the present invention in that it does not criticize, discredit, or otherwise discourage the use of bidding agreements to dealers. *See* MPEP §2141.02. In fact, Holden supports the use of bidding agreements for dealers/sellers in that it does not limit the bidding agreement to only buyers and in fact states the bidding agreement “acknowledges that all bids placed in an auction reflect a binding, irrevocable commitment on behalf of the bidder to purchase or *sell* product at the bid price” (¶0051, emphasis added).

In response to applicant's argument regarding claim 21 that the reference Freeland teaches away from the present invention because it is directed to facilitating transfer to titled properties whereas the present invention uses teaches a different methodology (Remarks, page 10), the Examiner disagrees. Freeland does not criticize, discredit, or otherwise discourage the review of various reports related to property, and therefore does not teach away from the present invention. *See* MPEP §2141.02. In fact, Freeland supports the review of various reports in preparation for a purchase of an automobile (¶0003).

In response to applicant's argument regarding claim 22 that the reference Chaves teaches away from the present invention because it is directed towards used automobile trade-in commerce bids whereas the present invention uses teaches a different methodology (Remarks, page 10), the Examiner disagrees. Chaves does not criticize, discredit, or otherwise discourage the option of trading in a vehicle as part of specification information, and therefore does not

teach away from the present invention. See MPEP §2141.02. In fact, Chaves supports the use of trade-in information as part of specification information (§§0010, 0027, 0037, 0039 and 0054).

In response to applicant's argument regarding claim 23 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the method deviates from a set point and not a range, (Remarks, page 10)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that "it is not permissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention," (Remarks, page 11), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references (Remarks, page 11), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where **there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine each of the references

Art Unit: 3625

were found as suggested by the references themselves of in the knowledge of one of ordinary skill in the art, as indicated in the previous office action and below.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 contains the limitation “obtain the distance between the consumer’s zip code and the dealer’s zip code.” It is not possible to obtain the distance between zip codes as zip codes are numerical identifications of certain geographical locations and, as such, cannot be measured. For purposes of this action only, the Examiner interprets this limitation as the distance based on the geographical areas identified by the zip codes. Because claims 14-19 are dependencies of claim 13, they inherit the same deficiency, are rejected on the same bases and interpreted in the same manner.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in

Art Unit: 3625

entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-14, 16-20 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ghouri et al., US 2002/0082978 A1 (hereafter referred to as “Ghouri”) in view of Holden et al., US 2001/0032175 A1 (hereafter referred to as “Holden”).

Referring to claim 10. Ghouri discloses a method of automating the reverse auction negotiation service between a consumer and a plurality of automobile dealers in order to provide the consumer with the lowest price for a new or used automobile of the consumer's specification (*see* Abstract), the method comprising the computer implemented steps of:

- the consumer specifying a desired make, model, and related specifications of desired automobile from an automobile data base, confirming the service contract, and providing the consumer's zip code location (Figs. 2-5 and 8 and pages 4-5, ¶¶0052, 0053, 0057 and 0058 – note the zip code is included in the mailing address);

Art Unit: 3625

- inviting new automobile dealers from a dealer database matched to the consumer's desired make, model, and related specifications of desired automobile and the consumer's zip code location to participate in submitting new automobile price quotes in response thereto (page 5, ¶¶0066-0067);

- creating a reverse auction database for the particular consumer automobile selection including an auction term (Fig. 15 and pages 5-6, ¶¶0066-0068 and 0070 – note the reverse auction is the PriceWar);

- notifying the lowest bidder at the end of the auction term (Fig. 17 and page 17, ¶0068); and

- providing the consumer with the list of auction bids at the end of the auction term (Fig. 19 and page 6, ¶0072).

Ghouri does not disclose providing a bidding agreement to each participating dealer. Holden, in the same field of endeavor and/or pertaining the same issue, discloses a method for an electronic reverse auction including wherein any participating seller agrees to a bidding agreement (¶0051 – note the dealer is the bidder who can purchase or sell a product). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ghouri to include the teachings of Holden to allow providing a bidding agreement to each participating dealer. Doing so would allow help ensure that all bids are placed with the intention of honoring the price, increase the reliability and trustworthiness of the auction system, and increase customer satisfaction, as suggested by Holden et al. (page 4, ¶0051).

Referring to claim 11. Ghouri in view of Holden further discloses the method of claim 10 wherein a consumer who is not a current member of the service is provided with means for secure service logon and service payment, access featured services, and added to the service consumer database (Ghouri, ¶¶0057-0058).

Referring to claim 12. Ghouri in view of Holden further discloses the method of claim 11 wherein the consumer is provided with a receipt for each particular reverse auction subscribed to within the service's reverse auction database (Ghouri, Fig. 22 and ¶¶0073-0074 – note the receipt is the acceptance page).

Referring to claim 13. Ghouri in view of Holden further discloses the method of claim 10 wherein dealers within the dealer data base have the option of reviewing all active reverse auction databases for the participating consumers to identify the automobile and specifications selected, obtain the distance between the consumer's zip code and the dealer's zip code, obtain the present number of bids, obtain the current lowest bid, determine the amount of time remaining in the auction term, and, if not an invited dealer, request an invite to bid (Ghouri, Fig 17, and ¶¶0067-0069, 0077 and 0078 – note the present number of bids is the open bids, the current lowest bid is included in the bid history and the amount if time remaining is the auction term is the closing time).

Referring to claim 14. Ghouri in view of Holden further discloses the method of claim 13 wherein the consumer is provided the option of accepting or rejecting any dealer not initially invited and requesting an invitation to bid (Ghouri, ¶0072 – note that the consumer is provided with the option of accepting or rejecting any dealer, whether or not initially invited).

Referring to claim 16. Ghouri in view of Holden further discloses the method of claim 13 wherein only one bid per dealer is active during the term of the reverse auction (Ghouri, ¶0071 – note the maximum number can be set to one).

Referring to claim 17. Ghouri in view of Holden further discloses the method of claim 13 wherein participating dealers have the option of lowering or maintaining their current bid levels during the term of the reverse auction (Ghouri, ¶¶0068 and 0080).

Referring to claim 18. Ghouri in view of Holden further discloses the method of claim 13 wherein participating dealers have the option of raising their current bid levels during the term of the reverse auction only by contacting a customer support representative of the service (Ghouri, ¶¶0077-0078 – note the customer service representative is the manager who can correct bidding mistakes which include raising bid price).

Referring to claim 19. Ghouri in view of Holden discloses the method of claim 13 wherein the consumer have the option of lengthening the reverse auction term only by contacting a customer support representative of the service (Holden, ¶¶0056, 0069-0071 – note that the

customer support representative is the reviewer of confirmer through the review or confirmation process) in order to help thwart “snipers” (i.e. initiators who wait until the last minute to bid in hopes of outbidding others), so that there is no disincentive to bid early, thereby increasing the fairness and reliability of the auction, as suggested by Holden (¶0069).

Referring to claim 20. Ghouri in view of Holden further discloses the method of claim 10 wherein the consumer has the option of reviewing at any time during the term of the reverse auction the current bids, the bid history, invited dealers, the consumer's selected options, the time elapsed in the bid term, and related services (Ghouri, Fig. 19 and ¶0072).

Referring to claim 24. Ghouri in view of Holden further discloses the method of claim 11 wherein the consumer member featured services include buying a pre-owned automobile, buying a used automobile, obtaining free price quotations on automobiles, obtaining the lowest pricing for a specified automobile, or trading-in the consumer's existing automobile in the transaction for a new, pre-owned, or used automobile (Ghouri, ¶0072 – note the services include obtaining free price quotations and the lowest pricing for a specified automobile).

Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ghouri in view of Holden and further in view of Freeland, US 2002/0169640 A1 (hereafter referred to as “Freeland”).

Referring to claim 21. Ghouri in view of Holden discloses the method of claim 20, as discussed above, but does not disclose wherein the related services include automobile insurance,

Art Unit: 3625

automobile financing, consumer credit reports, and vehicle history reports. Freeland, in the same field of endeavor and/or pertaining to the same issue, discloses a method for facilitating the transfer of titles property, such as vehicles, including wherein a buyer has access to and can review automobile insurance, automobile financing, consumer credit reports, and vehicle history reports (§0003). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ghouri in view of Holden to further include the teachings of Freeland to allow for buyer to review automobile insurance, automobile financing, consumer credit reports, and vehicle history reports. Doing so would provide the buyer with more of the information and services electronically that in the past required a physical dealer, as suggested by Freeland (§0003).

Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ghouri in view of Holden and further in view of Chaves, US 2002/0042752 A1 (hereafter referred to as “Chaves”).

Referring to claim 22. Ghouri in view of Holden discloses the method of claim 10, as discussed above, but does not disclose wherein the consumer has the option of trading in an existing automobile as part of the specification information provided to participating dealers. Chaves, in the same field of endeavor and/or pertaining to the same issue, discloses a method and system for selling motor vehicles over the Internet including wherein the consumer may trade in an existing automobile as part of the specification information provided to participating dealers (§0010, 0027, 0037, 0039 and 0054). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ghouri in view of Holden

Art Unit: 3625

to further include the teachings of Chaves to allow for the consumer to trade in an existing automobile as part of the specification information provided to participating dealers. Doing so would provide a more fully functional, remote, electronic method for dealers to better service and sell to their customers that in the past required a physical dealer, as suggested by Chaves (¶0001).

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ghouri in view of Holden and further in view of Gologorsky et al., US 2004/0186805 A1 (hereafter referred to as "Gologorsky").

Referring to claim 23. Ghouri in view of Holden discloses the method of claim 10, as discussed above, wherein participating dealers provide quotes above, at, or below invoice or the manufacturer's suggested retail price, but does not disclose wherein the quotes are based upon a whole dollar amount. Gologorsky, in the same field of endeavor and/or pertaining to the same issue, discloses a method of conducting auctions including wherein quotes are based upon a whole dollar amount (¶0165). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ghouri in view of Holden to further include the teachings of Gologorsky to allow for quotes to be based upon whole dollar amounts. Doing so would provide a more efficient auction process by not littering the bids with trivial differences in quotes.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ameer A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

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AAS

November 3, 2006


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